

Attorney Docket No.: J3747(C)
Serial No.: 10/592,921
Filed: September 14, 2006
Confirmation No.: 6265

REMARKS

By this Amendment, applicants have cancelled claim 10, without prejudice. Accordingly, the claims now pending are claims 1-9 and 11, as previously amended.

Applicants believe that the cancellation of claim 10 overcomes the rejections under 35 USC §101 and 35 USC §112 since these rejections are now moot.

At page 4 of the Office Action, the Examiner has rejected claims 1-11 under 35 USC §103(a) as allegedly unpatentable over U.S. Publication No. 2004/0115159 A1 to Tadlock et al. (hereinafter, "Tadlock") in view of U.S. Patent No. 4,102,795 to Minegishi (hereinafter, "Minegishi").

Tadlock is said to teach a pharmaceutical product for hair that contains at least one cationic surfactant and an amphoteric. More specifically, as far as applicants understand, the Examiner's position appears to be:

- 1) the compound of claim 1(a) (e.g., cetyl trimethyl ammonium chloride or cetrimonium bromide or chloride) is disclosed as a potential cationic (it is part of the principal nano-emulsion emulsifier of Tadlock which comprises a ternary system of surfactants comprising cationic, anionic and bridging surfactant);
- 2) the second cationic of our inventive system (component of 1(c)) is not specifically disclosed but (a) Tadlock states that the cationics and anionics of ¶13 are noted by way of example only; and (b) at ¶14 there is disclosed a

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dihydroxy ethyl stearylamine (applicants would note that this a different structure from the hydroxy ethyl, dimethylammonium alkylamine of our invention) which, given that cationics are noted "by way of example only" is related in that it is an alkylamine. The Examiner also notes that the specific cationic of our invention (i.e., Luviquat[®] Mono CP) is known in the art; and
3) the dialkyl imidazoline of our system (component of 1(b)) is also not specifically disclosed but (a) Tadlock discloses broadly at ¶17 that the amphoteric of the ternary emulsifier may be imidazoline and (b) Minegishi discloses dialkyl imidazoline quats in hair care compositions so, the Examiner reasons, such compounds are known and it would have been obvious to combine them with components 1(a) and 1(c) to form the system of our invention.

This rejection is respectfully traversed for reason set forth below.

The present invention is directed to conditioner compositions, e.g., for treatment of hair typically after shampooing (see page 3, line 9-11). The compositions comprise a specific combination of two very specific cationic surfactants (1(a) and 1(c)) in combination with a specific dialkyl imidazoline quat. At page 26 of the application, applicants have specifically demonstrated that use of the specific cationic of 1(c) in combination with 1(a) and 1(b) provides advantages not seen when using 1(a) and 1(b) alone in otherwise identical compositions. This is both unexpected and completely unpredictable.

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The Examiner seems to be of the position that it would have been obvious to make the specific combination of (a), (b) and (c) because each of the components were individually known in the art (e.g., Luviquat[®] component 1(c) was known quat ammonium salt; component 1(b) was known from Minegeshi) and, therefore, it would be obvious to a person of ordinary skill in the art that these components, respectively, could be used as amphoteric and cationic surfactants of Tadlock.

However, the Examiner cannot simply select individual components and state it would be obvious to combine them. Specifically, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the art. In re *Fritch*, 972 F.2d, 1260, 1265 (Fed. Cir. 1992).

"In determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re *GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted). Nevertheless,

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

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KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, ___, 127 s. Ct. 1727, 1741 (2007) (emphasis added). Stated differently, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977 , 988 (Fed. Cir. 2006) (emphasis added)).

In the present case, it is first pointed out, as the Examiner herself notes, the Tadlock teaches neither 1(b) not 1(c) components. With regard to 1(b) the Examiner can only say that imidazoline is broadly disclosed at ¶17 of Tadlock and that dialkyl imidazolines are broadly known from Minegeshi. There is nothing specific which would have prompted action and no articulated reason why a person of ordinary skill in the art would have chosen specifically to have combined an imidazoline (disclosed only broadly in ¶17), let alone a specific dialkyl imidazoline specifically (even if the compound was generally known) not only with a cetyl trimethyl ammonium chloride (one of many possible cationics) but even further with a second specific cationic (component 1(c)) which is not even disclosed in Tadlock.

Further, that Luviquat[®] is known generally offers no reason why a person of ordinary skill in the art would have specifically selected that among thousands and thousands of cationic quats to combine specifically with both components 1(a) and 1(b), assuming there even would have been the motivation to combine 1(a) and 1(b) in the first place.

That is, there was no good reason to make a combination even of 1(a) with 1(b), 1(b) with 1(c) or 1(a) and 1(c), let alone a combination of all three. The Examiner has simply failed to point out any prima facie case for making such specific combination.

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Moreover, as noted above, applicants have specifically tested at page 26 an example showing criticality between compositions with components 1(a) and 1(b) alone versus those having 1(a), (b) and (c) in combination. This clearly demonstrates that the nature of these combinations is unexpected and quite unpredictable.

Finally, applicants would point out that the whole tone of the Tadlock invention is about specific emulsifier for compositions comprising cationic, amphoteric (bridging surfactant) and anionic. Such anionics are used in shampoo compositions for cleansing and are generally avoided in conditioner compositions. The point is that Tadlock again would not motivate the person of ordinary skill to look for a combination of cationic and amphoteric (let alone the specific combination of the invention) to provide a superior conditioning application because the reference is concerned with shampoo compositions.

Again, applicants believe that the Examiner has provided a classic case of picking and choosing among components and that no *prima facie* showing has been made. Applicants have not addressed the issue relating to ranges because this is not deemed relevant in view of the fact that there is no case for combining the components at all, regardless of their proportions.

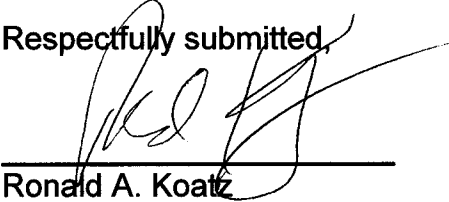
With respect to the rejection of the various dependent claims, applicants believe that those rise and fall with the allowance of claim 1.

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In view of the amendments and discussion above, including the deletion of claim 10, it is respectfully requested that the Examiner withdraw the rejection of the claims and that the claims, as amended, be allowed.

If a telephone conversation would be of assistance in advancing prosecution of the subject application, applicants' undersigned agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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